

REMARKS

Claims 1-17, 24-27, 29, 30 and 34-36 were pending in the application and were subjected to a Restriction Requirement as set forth below.

I. RESTRICTION REQUIREMENT

The Office Action states that the present claims comprise four independent inventions as follows

Group	Claims	Drawn to:
I	1-17	a method for obtaining a prognosis for an "inflammatory condition" comprising determining a thrombomodulin genotype.
II	24-26	a method for selecting subjects for "determining the efficacy of a candidate drug" comprising determining a thrombomodulin genotype.
III	27, 29-30, 34, 36	oligonucleotide probes and arrays thereof
IV	35	a computer readable medium.

The Action alleges that the restriction is being made because, under PCT Rules, the groups do not relate to a single general inventive concept, and therefore lack the same or a corresponding special technical feature that would define a contribution over the prior art. The Action contends that Groups I-II and IV share a technical feature in that each of Groups I-II require the determination of the thrombomodulin genotypes associated with an "inflammatory condition," (while Group IV is drawn to a computer readable medium comprising digitally encoded correlations between such genotypes and such conditions). Groups I-II allegedly share a technical feature with Group III: the Group III reagents of may be employed in genotype determination per Groups I-II.

The basis for the disunity resides in the Office's contention that correlations between thrombomodulin genotypes and inflammatory conditions were already known in the art at the time the instant invention was made, citing Park *et al.*, *Hypertens Res* 25:389-394 (2002) which was cited in Applicants' IDS. Park is said to teach an association between myocardial infarction and thrombomodulin genotype. The Action notes that myocardial infarction (MI) is clearly encompassed by, *e.g.*, claim 11, reciting "severe cardiovascular" dysfunction, of which MI is one type. Thus, the currently claimed genotype correlations allegedly do not make a contribution over the prior art and cannot constitute a special technical feature under PCT Rule 13.2. Park is further cited for its disclosure of oligonucleotides that meeting the requirements of Group III (citing to Table 2), as disclosing allele-specific oligos targeting the C1418T SNP that corresponds to the

polymorphism identified by applicant as occurring at position 4007 of SEQ ID NO:1 (see, e.g., page 3 of the specification).

II. APPLICANTS' RESPONSE

Election of Invention

Applicants traverse the above Restriction on the basis that the it would not burdensome to examine all three indicated groups together under MPEP 806.05(c). Moreover, the discussion below about the proper interpretation of what Park actually discloses would lead to a conclusion that it does not provide a basis for disunification. Thus, for either or both of the above reasons, Applicants request reconsideration of this restriction.

To advance prosecution, however, Applicants elect, Group I (method claims 1-17 and withdraw from consideration the claims that constitute Groups II - IV.

III. 2nd PRELIMINARY AMENDMENT

Claim 1 is amended to recite two SNPs at positions 5318 or 4007 of SEQ ID NO:1 each of which is indicative of an ability of the subject to recover from an inflammatory condition. Claim 2 is now amended to recite only one of those two SNPs, at position 5318. Claim 3 is canceled as its subject matter has been incorporated into claim 1. Applicants contend that the Park reference admits (at page 393, near bottom of left col.) that their C1418T SNP was not an independent risk factor for cardiovascular disease (neither one-vessel, two-vessel, nor 3-vessel disease). Further on, at page 394, left col. Top, the authors admit that their sample sizes were too small to draw conclusions. Therefore, Park should have no impact as prior art on the present claims as it does not teach that the 1418 SNP has any predictive value for risk of myocardial infarction (let alone any other inflammatory condition).

Claim 10 and 13 are amended to recite “the” instead of “an” inflammatory condition.

Claim 16 is amended to correct certain clerical/spelling errors.

These amendments do not introduce new matter and their entry is respectfully requested.

As a result of the foregoing election, amendments and cancelations, , the status of the claims is as follows:

Pending claims: 1, 2, 4-17, 24-27, 29, 30 and 34-36

Active claims: **1, 2 and 4-17.**

Withdrawn claims: 24-27, 29, 30 and 34-36 (*reconsideration requested*)

IV. CONCLUSION

Applicants respectfully request entry of the foregoing claims as amended, Applicants' elections and request for reconsideration of the restriction requirement as discussed. The application is now in condition for Examination on the merits and allowance.

Respectfully submitted,

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